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AFA

PATENT
ATTORNEY DOCKET NO.: 040894-7392

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Nobuaki YAGI)	Confirmation No.: 5562
)	
Application No.: 10/567,860)	Art Unit: 3721
)	
Filed: February 10, 2006)	Examiner: L. Low
)	
For: PAPER-PRESSING TABLE LOCK)	Mail Stop Appeal Brief - Patents
MECHANISM OF A STAPLER)	
(AS AMENDED))	

Commissioner for Patents
U.S. Patent and Trademark Office
Mail Stop Appeal Brief - Patents
Alexandria, VA 22314

Sir:

**APPELLANT'S BRIEF UNDER
37 C.F.R. § 41.37 TRANSMITTAL FORM**

1. Transmitted herewith is an Appeal Brief Under 37 C.F.R. § 41.37 which is being submitted further to the Notice of Appeal filed December 22, 2008.
2. Additional papers enclosed:
 - ☐ Request for Presence at the Appeal Conference
 - ☐ Form PTO-1449, _____ references included
 - ☐ Citations
 - ☐ Declaration of Biological Deposit
 - ☐ Submission of "Sequence Listing", computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.

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3. Oral Hearing Under 37 C.F.R. § 41.47

- ☐ Oral hearing is hereby requested.
☐ Fee under 37 C.F.R. § 41.29(b)(3) is enclosed.

4. Extension of Time

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136(a) apply.

- ☒ An extension of time was previously secured. Applicant believes that no additional extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.
- ☐ Applicant petitions for an extension of time, the fees for which are set out in 37 C.F.R. § 1.17(a), for the total number of months checked below:

<u>Total Months Requested</u>	<u>Fee for Extension</u>	<u>[Fee for Small Entity]</u>
<input type="checkbox"/> one month	\$ 130.00	\$ 65.00
<input type="checkbox"/> two months	\$ 490.00	\$ 245.00
<input type="checkbox"/> three months	\$ 1,110.00	\$ 555.00
<input type="checkbox"/> four months	\$ 1,730.00	\$ 865.00

Extension of time fee due with this request: \$_____.

If an additional extension of time is required, please consider this a Petition therefor.

- ☐ An extension for _____ months has already been secured and the fee paid therefor of \$_____ is deducted from the total fee due for the total months of extension now requested.

5. Constructive Petition

- ☒ EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

6. Fee Payment

- ☐ No fee is to be paid at this time.
- ☒ Please charge Deposit Account No. 50-0310 the amount of **\$540.00** for filing a brief in support of an Appeal.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, including fees due under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account 50-0310.

Respectfully submitted,

MORGAN LEWIS & BOCKIUS LLP

By: 

David E. Connor
Reg. No. 59,868

Dated: February 20, 2009

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Sir:

APPELLANT'S BRIEF UNDER 37 C.F.R. § 41.37

This brief is in furtherance of the Notice of Appeal, filed in the above-identified patent application on December 22, 2008.

1. The Real Party In Interest

The real party in interest in this appeal is Max Co., LTD. of Tokyo, Japan.

2. Related Appeals and Interferences

Appellant is not aware of another appeal for this case.

3. Status of Claims

The status of the claims is as follows:

Claim rejected: 1, 2, and 3.
Claims objected to: none.
Claims allowed: none.
Claims withdrawn: none.
Claims canceled: 4 and 5.
Claim appealed: 1, 2, and 3.

4. Status of Amendments

An Amendment was filed on October 24, 2008 subsequent to the Final Office Action dated July 24, 2008. The Amendment was entered by the Examiner. Accordingly, the pending filed claims are attached as Appendix A to this brief.

5. Summary of the Claimed Subject Matter

An aspect of Appellant's present invention relates generally to a paper-pressing table lock mechanism of a stapler for fixing a table, on which sheets of paper to be stapled are set, in a paper-pressing state and releasing the fixed table immediately after clinching each leg of a stapled penetrating the sheets of paper.

Independent Claim 1

With respect to independent claim 1, as discussed in Appellant's specification beginning at the fourth paragraph on page 7 and shown in FIGs. 1-8.

According to the table lock mechanism, if the sheets of paper to be stapled (a) are set on a stapling table (1) and the motor of the electric stapler is activated, a table link (3) rotates in the counterclockwise direction to move downward as shown in Fig. 4, and a table (8) thereof strongly presses the sheets of paper (a). However the table link (3) and a fixing plate (5) are not yet engaged. See page 7, lines 19-24 and FIG. 4 of the specification. A return link (4) rotates in the clockwise direction to allow the rotation of the table link (3). As shown in FIG. 5, a cam (7) also rotates at this time, and a pin (20) of a table fixing link (6) is engaged with the periphery of the fixing cam (7), but is closer to the cam center. Therefore, since the table fixing link (6) is rotated in the clockwise direction by a spring force, the fixing plate (5) slides in a wedge shape along a guide groove (17), and the lower surface thereof is engaged with the upper portion of a fixing pin (13) of the table link (3). See page 8, lines 5-13 and FIG. 5 of the specification. Accordingly, the table link (3) is locked so as not to move upward. As a result, the table link (3) is locked in a state where the table (8) strongly presses the sheets of paper to be stapled (a).

A pressure reducing mechanism temporarily reduces the pressure by a clinch lever (26) with respect to a clincher link (25). See page 11, line 17 and FIGS. 9-12B of the specification. A pressure reducing unit is constructed with a stepped portion (35) (*i.e.*, concave section) with respect to an engagement pin (33) of the clinch lever (26), which is formed on a circular arc section (34) of a clinch cam (27). The stepped portion (35) is formed in a portion slightly shifted

from the end of the circular arc section (34). See page 11, lines 17-24 and FIG. 12B of the specification. When the engagement pin (33) of the clinch lever 26 is engaged with the stepped portion (35), the pressure of the clinch lever (26) with respect to the clincher link (25) is reduced. At this time, the fixing plate (5) may be drawn out.

When the clinch cam (27) rotates so that the engagement pin (33) moves to the position corresponding to the concave section (35) as shown in FIG. 12B, immediately after the engagement pin (33) of the clinch lever (26) is pushed out by the end portion of the circular arc section (34) so as to clinch the leg of the staple as shown in FIG. 12A. As shown in FIG. 10, the press-contacting force of the clinch lever (26) with respect to the clincher link (25) is reduced in the direction of an arrow when the concave portion (35) is engaged by engagement pin (33). Therefore, by pushing up the movable clincher (12) so that the force against a driver (2) is reduced, looseness between the driver (2) and the clinch link (25) occurs. Because the force against the driver (2) is reduced commensurate with the looseness, the fixing plate (5) can be drawn out and moved to the initial position without excessive force. See page 12, lines 6-21 and FIG. 12B of the specification.

6. **Grounds of Rejection To Be Reviewed On Appeal**

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,791,543 to *Udagawa, et al.*, ("*Udagawa*"), in view of Admitted Prior Art.

7. Argument

(i) Rejections under 35 U.S.C. § 112, first paragraph

No claims are presently rejected under 35 U.S.C. § 112, first paragraph.

(ii) Rejections under 35 U.S.C. § 112, second paragraph

No claims are presently rejected under 35 U.S.C. § 112, second paragraph.

(iii) Rejections under 35 U.S.C. § 102

No claims are presently rejected under 35 U.S.C. § 102.

(iv) Rejections under 35 U.S.C. § 103

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,791,543 to *Udagawa, et al.*, (“*Udagawa*”), in view of Admitted Prior Art. Appellant respectfully traverses this rejection as being based upon references that when combined neither teach nor suggest the novel combination of features recited in independent claim 1.

The Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. If the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness as to a given claim, then that claim is not obvious without any evidence of nonobviousness by the Appellant.

At issue are claims 1-3 rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,791,543 to *Udagawa, et al.*, (“*Udagawa*”), in view of Admitted Prior Art. Appellant respectfully submits that the Office Action has not established a *prima facie* case of obviousness at least because *Udagawa*, whether alone or in combination, fails to teach or suggest

all the recited features of independent claim 1. Independent claim 1 recites, in part, “a fixing plate linearly slidable with respect to the fixing pin and engagable with the fixing pin to lock the table link in a paper-pressing state . . . wherein the table link and the fixing plate are separate members, and the table link and the fixing plate are relatively movable to each other.” These features are not found in *Udagawa*. Thus, *Udagawa* fails to teach or suggest at least these features of independent claim 1.

The Office Action admits in section 8 on page 4 of the July 24, 2008 Final Office Action, that *Udagawa* fails to disclose “the table link and fixing plate being separate members.” In the previous Office Action dated November 16, 2007, the Office asserted that member 152 of *Udagawa* was the claimed “table link,” and member 152A of *Udagawa* was the claimed “fixing plate.” Nevertheless, the Final Office Action takes Official Notice that the corresponding structure in *Udagawa* may be separated into two parts as in the present invention. However, such notice is problematic because members 152 and 152A are portions of the same member and are an integral structure. See, for example, Figs. 3 and 17 of *Udagawa*. Claim 1 requires that the table link and fixing plate be separate members and the fixing plate be capable of locking the table link in a paper-pressing state. It is impossible for the fixing plate to lock the table link if they are integrated portions of the same member, as is the case in *Udagawa*.

Further, the features “wherein the table link and the fixing plate are separate members, and the table link and the fixing plate *are relatively movable to each other*,” further delineate that the alleged table link 152 and alleged fixing plate 152A of *Udagawa* cannot make obvious claim 1 because they are not relatively movable to each other. Emphasis added. In contrast, in the

present invention, Fig. 2 shows the table link (3) and the fixing plate (5) are separate members and are relatively movable to each other. Thus, *Udagawa* cannot make obvious the present invention.

The Office Action erroneously states that the rejection of claims 1-3 is also in view of Admitted Prior Art (APA), but then indicates that the Examiner is taking Official Notice that it would have been obvious to form a structure as two separate parts. However, this Official Notice is also defective because "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." See M.P.E.P. § 2144.03. The Official Notice taken is not appropriate because the Examiner's alleged facts are not well-known or common knowledge within the art. Further, the table link 3 and fixing plate 5 of the present invention (Fig. 1) cannot be made obvious by the alleged integrated table link 152 and fixing plate 152A of *Udagawa* because the table link 3 and fixing plate 5 perform very different operations and must be separate and engaging. That is, the table link 3 connects the table 8 (and movable clincher) to the main body of the stapler, while the fixing plate 5 slides in a wedge shape along a guide groove, and its lower surface is engaged with the upper portion of a fixing pin 13 of the table link 3 to place the table link 3 in a locked position to improve stapler performance. See page 8, lines 5-13 and FIG. 5 of the specification. Thus, the table link 3 and the fixing plate 5 must be separate components in order to achieve the desired performance and cannot be the alleged integrated table link 152 and alleged fixing plate 152A of *Udagawa*.

As pointed out in M.P.E.P. § 2143.03, all the claimed limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. Because *Udagawa*, whether taken alone or in combination, fails to teach or suggest each feature of independent claim 1, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Additionally, Appellant respectfully submits that dependent claim 2-3 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

Appellant respectfully requests that the Board withdraw the rejection of claims 1-3 for all the reasons above-mentioned. Applicant re-asserts that Official Notice is not appropriate because the Examiner's alleged facts are not well-known or common knowledge within the art and have not been shown to be capable of instant and unquestionable demonstration as being well-known. See M.P.E.P. § 2144.03.

(v) Other Rejections

No claims are presently rejected under grounds other than those referred to above.

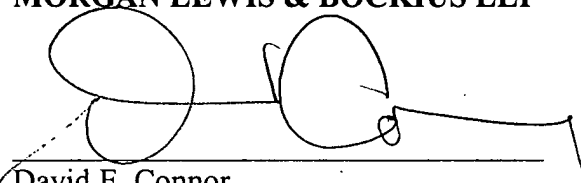
In view of the foregoing, Appellant respectfully requests the reversal of the Examiner's rejection and allowance of the pending claims. If there are any other fees due in connection with the filing of this Appeal Brief, please charge the fees to our Deposit Account No. 50-0310.

If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account No. 50-0310.

Respectfully submitted,

MORGAN LEWIS & BOCKIUS LLP

By:



David E. Connor
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Dated: February 20, 2009

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8. Claims Appendix

Claim 1 (Previously Presented): A paper-pressing table lock mechanism of a stapler comprising:

- a table link rotatably provided in a base;
 - a paper-pressing table provided on the table link;
 - a movable clincher provided on a leading end of the paper-pressing table;
 - a fixing pin projecting on a side surface of the table link;
 - a fixing plate linearly slidable with respect to the fixing pin and engagable with the fixing pin to lock the table link in a paper-pressing state;
 - a driver that drives a staple to sheets of paper to be stapled pressed against the paper-pressing table;
 - a clincher link that is rotatably provided in the base so as to press the movable clincher of the table link in the paper-pressing state from an opposite side of the driver and that clinches each leg of the staple penetrating the sheets of paper to be stapled;
 - a clinch lever that presses the clincher link; and
 - a pressure reducing mechanism that temporarily reduces the pressure by the clinch lever with respect to the clincher link;
- wherein the table link and the fixing plate are separate members, and the table link and the fixing plate are relatively movable to each other.

Claim 2 (Previously Presented): The paper-pressing table lock mechanism of a stapler according to claim 1, wherein the pressure reducing mechanism comprises a sector-shaped cam, and a periphery of the sector-shaped cam is engaged with the clinch lever,

the sector-shaped cam has a stepped portion formed on the periphery of the sector-shaped cam, and

when the clinch lever is engaged with the stepped portion, a pressure with respect to the clincher link is reduced.

Claim 3 (Previously Presented): The paper-pressing table lock mechanism of a stapler according to claim 2, wherein the sector-shaped cam comprises a first and second sector-shaped cams, the first and second sector-shaped cams have the same external feature, and the first and second sector-shaped cams are mounted on a common driving shaft so as to rotate at the same phase.

Claims 4-5 (Canceled).

9. **Evidence Appendix**

No information is appended under this section.

10. **Related Proceedings Appendix**

No information is appended under this section.